

REMARKS

In the Office Action, the Examiner noted that claims 33-36 and 38-69 are pending in the application; that claims 33-36 and 38-69 are rejected; and that claim 37 is canceled without prejudice or disclaimer. By this response, claims 36, 38-53 and 56, 58, 62, 63, and 66-68 continue unamended; claims 33, 34, 35, 54, 55, 57, 59, 60, 61, 64, 65, and 69 are amended. In view of the following discussion, the Applicants submit that none of the claims now pending in the application is indefinite, anticipated, or obvious under the respective provisions of 35 U.S.C. §§112, 102, or 103. Thus, the Applicants believe that all of these claims are now in allowable form.

REJECTION OF CLAIMS UNDER 35 U.S.C. §112

The Examiner rejected claims 64 and 65 under 35 U.S.C. §112, first paragraph; and claims 57 and 59-61 under 35 U.S.C. §112, second paragraph. The Applicants traverse the rejections.

The Applicants have amended claims 57, 59-61, 64 and 65 as indicated above. The amendments to the claims add no new matter and are supported in the specification as originally filed. For example, the Applicants' Fig. 4 clearly depicts a "post having a tapered series of truncated sections separated by serrations," as recited in claims 64 and 65.

As such, the Applicants' request reconsideration and withdrawal of the 35 U.S.C. §112 rejection of claims 57, 59-61, 64 and 65.

REJECTION OF CLAIMS UNDER 35 U.S.C. §102

The Examiner rejected claims 33, 34, 38, 41, 53, and 55 under 35 U.S.C. §102(e) as being anticipated by Reynaud et al. (U.S. Patent No. 5,328,372, issued July 12, 1994) ("Reynaud"). The Applicants traverse the rejection.

Reynaud discloses the use of a composite material comprising carbon fibers embedded in an epoxy resin or

polyester resin. Thus, the composite material comprises the carbon fibers and the resin. Reynaud further discloses that the carbon fibers are "continuous ... equally tensioned and with unidirectional longitudinal arrangement in the axis of the peg." (Reynaud at col. 2, line 59 - col. 3, line 2). In other words, Reynaud requires that all of the carbon fibers are axially aligned. In addition, Reynaud discloses that "100% of the carbon fibers are continuous from end of the peg to the other end of the peg." (Reynaud at col. 2, lines 13-19).

[T]he equally tensioned fibers occupy 64% of the total volume [of the fiber and resin composite] or the total weight as the density of these fibers is substantially equal to that of the epoxy resin. This very high rate of fibers gives the peg exceptionally high values in shear ... which avoid[s] any fracture of the peg. (See col. 3, lines 3-12).

In contrast, the Applicants disclose in Claim 33 a post which comprises glass fibers (e.g., fiberglass fibers as in dependent Claim 34). The Applicants' posts comprise specific types of glass fibers that are not disclosed by Reynaud.

As noted standard composite material literature, composite materials made of carbon/graphite rods in a resin are generally stiffer and less flexible than composite materials made of fiberglass fibers in a resin. For example, according to the website of Aerospace Composite Products (acp-composites.com) solid carbon rods

"are extremely stiff and lightweight and have a very low coefficient of expansion."

Furthermore, graphite composites used in making fishing rods can create weak points along the rod. For example, in the website of stcroixrods.com, a special integrated poly curve [™] (IPC) rod eliminates inherent weak points of

fishing rods made of graphite and resins when rolling the graphite. However the IPC rods are considered stronger because:

"stress is distributed along the entire blank. IPC tapers result in superior graphite fiber alignment along the length of the blank. This ensures better longitudinal strength because alignment is never distorted at transition points. It results in more uniform strength, stiffness and sensitivity along the entire blank shaft for vibration transmission and enhanced feel".

Therefore, all other factors being equal, graphite composite materials have what would be a disadvantage in dental posts subject to longitudinal stress from biting, namely that stress is distributed along its entire length and that it has a stiffness, which is undesirable when flexibility is desired, as in a composite material endodontic post.

In contrast, according to the website of chemposite.com

"(t)he flexibility of fiberglass is the perfect material for custom shapes and forms."

A comparison of fiberglass composite material and graphite composite material made of graphite and epoxy in the website of performancecomposites.com reveals that graphite composite material is five times stiffer than fiberglass composite material. For example, a test of composite materials made of graphite and epoxy has a stiffness of 8×10^6 psi, while a test of fiberglass fibers and resin reveals that the fiberglass composite material has a stiffness of 1.2×10^6 psi. This five fold disparity occurs even though the densities of fiberglass composite material ($.055 \text{ lb/in}^3$) and graphite composite material ($.065 \text{ lb/in}^3$) are relatively similar.

Moreover, a further comparison of E-glass/epoxy unidirectional fiberglass prepreg with AS/3501 carbon/epoxy unidirectional prepreg reveals wide disparities of

flexibility vs. stiffness of these two materials in Berenberg; Barry, About Composites/Plastics textbook quoted in the website of composite.about.com. E-Glass/epoxy unidirectional prepreg has a lower longitudinal modulus of elasticity of 5.7 (indicating flexibility) vs. AS/3501 carbon/epoxy unidirectional prepreg having a modulus of elasticity of 20 (indicating stiffness).

Therefore, although stiffer carbon rod manufactured endodontic posts are disclosed in Reynaud, fiberglass based manufactured endodontic posts were not disclosed or suggested by Reynaud.

Applicants' independent claims 33 and 55 each recite a post utilizing glass fibers. The Applicants maintain that this recited difference between the Applicants' invention and the invention disclosed by Reynaud is sufficient to overcome the rejection. In addition, claims 38, 41, 53 (which depends either directly or indirectly from claim 33) also is not anticipated by Reynaud at least for their dependency upon claim 33. As such, the Applicants submit that the claims are not anticipated by Reynaud. Therefore, the Applicants request reconsideration and withdrawal of the anticipation rejection of the claims.

REJECTION OF THE CLAIM UNDER 35 U.S.C. §103

The Examiner rejected under 35 U.S.C. §103(a) claims 35, 36, 42-50, 54, and 56-69 as being unpatentable over Reynaud; claim 39 as being unpatentable over Reynaud in view of Al Kasem (U.S. Patent No. 5,326,264, issued July 5, 1994); claim 51 as being unpatentable over Reynaud in view of Kennard (U.S. Patent No. 3,903,603, issued September 9, 1975); and claim 52 as being unpatentable over Reynaud in view of Weissman (U.S. Patent No. 5,326,263, issued July 5, 1994). The Applicants traverse the rejections.

A. Claims 35, 36, 40, 42-50, 54, and 59-69

The Examiner rejected under 35 U.S.C. §103(a) claims 35, 36, 42-50, 54, and 56-69 as being unpatentable over

Reynaud. The arguments presented against Reynaud with respect to the anticipation rejection are also applicable with respect to the instant rejection. As such, the Applicants incorporate those arguments herein.

Reynaud addresses the problem of matching the properties of a tooth. One of the problems addressed by the Applicants is also to match the properties of a tooth (to prevent cracking). The Applicants submit that Applicants solve this problem in such a way that teaches away from Reynaud. Specifically, the Applicants utilize fibers (i.e., fiberglass) that are different than the carbon fibers disclosed by Reynaud. The Applicants submit that the Examiner has looked at the problems solved and used impermissible hindsight to conclude that the Applicants invention is obvious. The Applicants submit that different materials have different characteristics (e.g., different modulus of elasticity) and that the shape of the post is designed in accordance with the properties of the materials used. In addition, the Applicants submit that there is nothing in Reynaud that suggests using fiberglass to make posts.

As such, the Applicants submit that because claims 33 and 55 utilize glass fibers these claims are not obvious in view of Reynaud. In addition, claims 34, 35, 36, 40, and 42-50 (which depends either directly or indirectly from claim 33); and claims 54 and 56-69 (which depends either directly or indirectly from claim 55) are also not obvious in view of Reynaud. Therefore, the Applicants request reconsideration and withdrawal of the obviousness rejection of the claims.

B. Claim 39

The Examiner rejected claim 39 as being unpatentable over Reynaud in view of Al Kasem. The Applicants incorporate the previous arguments regarding Reynaud as arguments against the rejection of claim 39. The addition

of Al Kasem does not correct the short-comings of Reynaud. For example, Al Kasem does not disclose utilizing posts having glass fibers. Claim 39 also contains posts having glass fibers (due to its dependency upon claim 33). As such, the Applicants maintain that Reynaud and Al Kasem either individually or in any reasonable combination do not render the Applicants' invention obvious. The Applicants request reconsideration and withdrawal of the obviousness rejection of claim 39.

C. Claim 51

The Examiner rejected claim 51 as being unpatentable over Reynaud in view of Kennard. The Applicants incorporate the previous arguments regarding Reynaud as arguments against the rejection of claim 51. The addition of Kennard does not correct the short-comings of Reynaud. For example, Kennard does not disclose utilizing posts having glass fibers. Claim 51 also contains posts having glass fibers (due to its dependency upon claim 33). As such, the Applicants maintain that Reynaud and Kennard either individually or in any reasonable combination do not render the Applicants' invention obvious. The Applicants request reconsideration and withdrawal of the obviousness rejection of claim 51.

D. Claim 52

The Examiner rejected claim 52 as being unpatentable over Reynaud in view of Weissman. The Applicants incorporate the previous arguments regarding Reynaud as arguments against the rejection of claim 52. The addition of Weissman does not correct the short-comings of Reynaud. For example, Weissman does not disclose utilizing posts having glass fibers. Claim 52 also contains posts having glass fibers (due to its dependency upon claim 33). As such, the Applicants maintain that Reynaud and Weissman either individually or in any reasonable combination do not render the Applicants' invention obvious. The Applicants request

reconsideration and withdrawal of the obviousness rejection of claim 52.

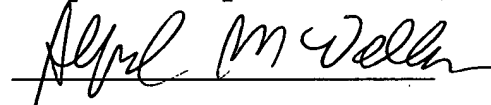
CONCLUSION

Thus, Applicant submits that none of the claims presently in the application are indefinite, anticipated, or double-patented under the respective provisions of 35 U.S.C. §§ 112, 102, or 101. Consequently, the Applicant believes that all these claims are presently in condition for allowance. Accordingly, both reconsideration of this application and its swift passage to issue are earnestly solicited.

If, however, the Examiner believes that there are any unresolved issues requiring the issuance of a final action in any of the claims now pending in the application, it is requested that the Examiner telephone the undersigned Alfred M. Walker, at (631) 361-8737 so that appropriate arrangements can be made for resolving such issues as expeditiously as possible.

Dated: August 13, 2004

Respectfully submitted,



Alfred M. Walker

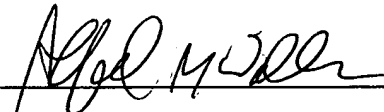
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CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as Express Mail #EV401839260US addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date indicated below.

Date: August 13, 2004



Alfred Walker

United States District Court

EASTERN DISTRICT OF NEW YORK

SUMMONS IN A CIVIL CASE

DR. ROBERT SICURELLI and
DR. SAMUEL MASYS

CASE NUMBER:

CV 03 4934

v.

JENERIC/PENTRON INC.

AMON, J.

GOLD, M.J.

TO: (Name and address of defendant)

Jeneric/Pentron Inc.
53 North Plains Industrial Road
Wallingford, CT 06492

YOU ARE HEREBY SUMMONED and required to serve upon PLAINTIFF'S ATTORNEY (name and address)

Bradford J. Badke, Esq.
Dewey Ballantine LLP
1301 Avenue of the Americas
New York, NY 10019-6092

an answer to the complaint which is herewith served upon you, within 20 days after service of this summons upon you, exclusive of the day of service. If you fail to do so, judgment by default will be taken against you for the relief demanded in the complaint. You must also file your answer with the Clerk of this Court within a reasonable period of time after service.

ROBERT C. HEINEMANN

CLERK

SEP 26 2003

DATE

(BY) DEPUTY CLERK

(Rev. 12/96)

CIVIL COVER SHEET

The JS-44 civil cover sheet and the information contained herein neither replace nor supplement the filing and service of pleadings or other papers as required by law, except as provided by local rules of court. This form, approved by the Judicial Conference of the United States in September 1974, is required for the use of the Clerk of Court for the purpose of initiating the civil docket sheet. (SEE INSTRUCTIONS ON THE REVERSE OF THE FORM.)

I. (a) PLAINTIFFS

Dr. Robert Sicurelli and Dr. Samuel Masry

DEFENDANTS

Jeneric/Pentron Inc.

(b) COUNTY OF RESIDENCE OF FIRST LISTED PLAINTIFF Nassau
(EXCEPT IN U.S. PLAINTIFF CASES)

COUNTY OF RESIDENCE OF FIRST LISTED DEFENDANT New Haven, Connecticut
(IN U.S. PLAINTIFF CASES ONLY)

NOTE: IN LAND CONDEMNATION CASES, USE THE LOCATION OF THE TRACT OF LAND INVOLVED.

(c) ATTORNEY'S FIRM NAME, ADDRESS, AND TELEPHONE NUMBER

Bradford J. Badke, Esq.
Dewey Ballantine LLP
1301 Avenue of the Americas
New York, NY 10019-6092

ATTORNEYS (IF KNOWN)

03 4934
AMON, J.

II. BASIS OF JURISDICTION (PLACE AN "X" IN ONE BOX ONLY)

- ☐ 1 U.S. GOVERNMENT PLAINTIFF
☐ 2 U.S. GOVERNMENT DEFENDANT
☐ 3 FEDERAL QUESTION (U.S. GOVERNMENT NOT A PARTY)
☐ 4 DIVERSITY (INDICATE CITIZENSHIP OF PARTIES IN ITEM III)

III. CITIZENSHIP OF PRINCIPAL PARTIES

(FOR DIVERSITY CASES ONLY)

PTF DEF

Citizen of This State ☐ 1 ☐ 1Citizen of Another State ☐ 2 ☐ 2Citizen or Subject of a Foreign Country ☐ 3 ☐ 3

(PLACE AN "X" IN ONE BOX FOR PLAINTIFF AND ONE BOX FOR DEFENDANT)
PTF DEF

Incorporated or Principal Place of Business in This State ☐ 4 ☐ 4Incorporated and Principal Place of Business in Another State ☐ 5 ☐ 5Foreign Nation ☐ 6 ☐ 6**IV. ORIGIN**

(PLACE AN "X" IN ONE BOX ONLY)

☐ 1 Original Proceeding☐ 2 Removed from State Court☐ 3 Remanded from Appellate Court☐ 4 Reinstated or Reopened

Transferred from
☐ 5 another district (specify)

☐ 6 Multidistrict Litigation

Appeal to District Judge
☐ 7 Magistrate Judgment

V. NATURE OF SUIT (PLACE AN "X" IN ONE BOX ONLY)**CONTRACT**

- ☐ 110 Insurance
☐ 120 Marine
☐ 130 Miller Act
☐ 140 Negotiable Instrument
☐ 150 Recovery of Overpayment & Enforcement of Judgment
☐ 151 Medicare Act
☐ 152 Recovery of Defaulted Student Loans (Excl. Veterans)
☐ 153 Recovery of Overpayment of Veterans' Benefits
☐ 160 Stockholders' Suits
☐ 190 Other Contract
☐ 195 Contract Product Liability

TORTS**PERSONAL INJURY**

- ☐ 310 Airplane
☐ 315 Airplane Product Liability
☐ 320 Assault, Libel & Slander
☐ 330 Federal Employers' Liability
☐ 340 Marine
☐ 345 Marine Product Liability
☐ 350 Motor Vehicle
☐ 355 Motor Vehicle Product Liability
☐ 360 Other Personal Injury

PERSONAL INJURY

- ☐ 362 Personal Injury - Mod. Malpractice Liability
☐ 365 Personal Injury - Product Liability
☐ 368 Asbestos Personal Injury Product Liability
☐ 370 Other Fraud
☐ 371 Truth in Lending
☐ 380 Other Personal Property Damage
☐ 385 Property Damage Product Liability

FORFEITURE/PENALTY

- ☐ 610 Agriculture
☐ 620 Other Food & Drug
☐ 625 Drug Related Scheme of Property 21 USC 881
☐ 630 Liquor Laws
☐ 640 R.R. & Truck
☐ 650 Airline Regs.
☐ 660 Occupational Safety/Health
☐ 690 Other

BANKRUPTCY

- ☐ 422 Appeal 28 USC 158
☐ 423 Withdrawal 28 USC 157

PROPERTY RIGHTS

- ☐ 820 Copyrights
☐ 830 Patent
☐ 840 Trademark

SOCIAL SECURITY

- ☐ 861 HIA (1395B)
☐ 862 Black Lung (923)
☐ 863 DIWC/DIWW (405(g))
☐ 864 SSID Title XVI
☐ 865 RSI (405(g))

FEDERAL TAX SUITS

- ☐ 870 Taxes (U.S. Plaintiff or Defendant)
☐ 871 IRS - Third Party 28 USC 7609

OTHER STATUTES

- ☐ 400 State Reapportionment
☐ 410 Antitrust
☐ 430 Banks and Banking
☐ 450 Commerce/ICC
☐ 460 Deportation
☐ 470 Racketeer Influenced and Corrupt Organization
☐ 810 Selective Service
☐ 850 Securities/Commodities/Exchange
☐ 875 Customer Challenge 12 USC 3410
☐ 891 Agricultural Acts
☐ 892 Economic Stabilization Act
☐ 893 Environmental Matters
☐ 894 Energy Allocation Act
☐ 895 Freedom of Information Act
☐ 900 Appeal of Fee Determination Under Equal Access to Justice
☐ 950 Constitutionality of State Statutes
☐ 890 Other Statutory Actions

VI. CAUSE OF ACTION

(CITE THE U.S. CIVIL STATUTE UNDER WHICH YOU ARE FILING AND WRITE BRIEF STATEMENT OF CAUSE
DO NOT CITE JURISDICTIONAL UNLESS DIVERSITY)

35 U.S.C. § 281 - patent infringement

VII. REQUESTED IN COMPLAINT:

☐ CHECK IF THIS IS A CLASS ACTION UNDER F.R.C.P. 23

DEMAND \$

CHECK YES ONLY IF DEMANDED IN COMPLAINT.

JURY DEMAND: ☒ YES ☐ NO**VIII. RELATED CASE(S) IF ANY**

(See Instructions):

JUDGE

DOCKET NUMBER

DATE

26 September 2003

SIGNATURE OF ATTORNEY OF RECORD

Bradford J. Badke

OFFICE USE ONLY

RECEIPT #

AMOUNT

APPLYING IF

JUDGE

MAG. JUDGE

Form was electronically produced by Elite Federal Forms, Inc.

TO: Commissioner of Patents and Trademarks Washington, DC 20231	REPORT ON THE FILING OR DETERMINATION OF AN ACTION REGARDING A PATENT OR TRADEMARK
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In Compliance with 35 § 290 and/or 15 U.S.C. § 1116 you are hereby advised that a court action has been
 filed in the U.S. District Court Eastern District of New York on the following ☒ Patents or ☐ Trademarks:

DOCKET NO.	DATE FILED 9/25/2003	U.S. DISTRICT COURT Eastern District of New York
PLAINTIFF Dr. Robert Sicurelli and Dr. Samuel Masyr		DEFENDANT Jeneric/Pentron Inc.
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1 5,518,399	5/21/1996	Dr. Robert Sicurelli and Dr. Samuel Masyr
2 5,741,139	4/21/1998	Dr. Robert Sicurelli and Dr. Samuel Masyr
3 5,915,970	6/29/1999	Dr. Robert Sicurelli and Dr. Samuel Masyr
4 5,919,044	7/6/1999	Dr. Robert Sicurelli and Dr. Samuel Masyr
5 6,371,763B1	4/16/2002	Dr. Robert Sicurelli and Dr. Samuel Masyr

In the above—entitled case, the following patent(s) have been included:

DATE INCLUDED	INCLUDED BY <input type="checkbox"/> Amendment <input type="checkbox"/> Answer <input type="checkbox"/> Cross Bill <input type="checkbox"/> Other Pleading	
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1		
2		
3		
4		
5		

In the above—entitled case, the following decision has been rendered or judgement issued:

DECISION/JUDGEMENT

CLERK	(BY) DEPUTY CLERK	DATE
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Copy 1—Upon initiation of action, mail this copy to Commissioner Copy 3—Upon termination of action, mail this copy to Commissioner
 Copy 2—Upon filing document adding patent(s), mail this copy to Commissioner Copy 4—Case file copy

Bradford J. Badke (BB-1335)
David F. Owens (DO-4776)
Lisa B. Deutsch (LD-8190)
DEWEY BALLANTINE LLP
1301 Avenue of the Americas
New York, New York 10019-6092
(212) 259-8000

Attorneys for Plaintiffs
Dr. Robert Sicurelli and Dr. Samuel Masyr

UNITED STATES DISTRICT COURT
EASTERN DISTRICT OF NEW YORK

DR. ROBERT SICURELLI
and DR. SAMUEL MASYR,

Plaintiffs,

vs.

JENERIC/PENTRON INC.,

Defendant.

Civil Action No. 03-

Civ. 4934 (CBA)

**COMPLAINT AND
DEMAND FOR JURY TRIAL**

Plaintiffs Dr. Robert Sicurelli and Dr. Samuel Masyr, for their Complaint against defendant Jeneric/Pentron Inc. ("Jeneric/Pentron"), alleges as follows:

1. This Court has subject matter jurisdiction of this action, which arises under the patent laws of the United States, pursuant to 28 U.S.C. §§ 1331 and 1338(a).
2. Venue is proper in this district under 28 U.S.C. §§ 1391(b), (c) and 1400(b).
3. Plaintiff Dr. Robert Sicurelli is a named inventor of each of the patents in suit. He practices dentistry and prosthodontics in Brooklyn, New York. He has been in practice for 18 years.
4. Plaintiff Dr. Samuel Masyr is a named inventor of each of the patents in suit. He practices dentistry and endodontics in Brooklyn, New York. He has been in practice for 31 years.

5. Dr. Sicurelli and Dr. Masyr jointly own all right, title and interest in and to each of the patents in suit.

6. Defendant Jeneric/Pentron, a Connecticut corporation having its principal places of business in Wallingford, Connecticut, is doing business and has carried out substantial trade and business within this judicial district and throughout the State of New York.

CAUSE OF ACTION FOR PATENT INFRINGEMENT

7. United States Patent No. 5,518,399 for METHOD OF RESTORING ENDODONTICALLY-TREATED TOOTH (the "399 patent"), a copy of which is annexed hereto as Exhibit A, was duly and legally issued on May 21, 1996, and Dr. Sicurelli and Dr. Masyr jointly own all right, title and interest in and to that patent.

8. United States Patent No. 5,741,139 for FLEXIBLE POST IN A DENTAL POST AND CORE SYSTEM (the "139 patent"), a copy of which is annexed hereto as Exhibit B, was duly and legally issued on April 21, 1998, and Dr. Sicurelli and Dr. Masyr jointly own all right, title and interest in and to that patent.

9. United States Patent No. 5,915,970 for FLEXIBLE POST IN A DENTAL POST AND CORE SYSTEM (the "970 patent"), a copy of which is annexed hereto as Exhibit C, was duly and legally issued on June 29, 1999, and Dr. Sicurelli and Dr. Masyr jointly own all right, title and interest in and to that patent.

10. United States Patent No. 5,919,044 for FLEXIBLE POST IN A DENTAL POST AND CORE SYSTEM (the "044 patent"), a copy of which is annexed hereto as Exhibit D, was duly and legally issued on July 6, 1999, and Dr. Sicurelli and Dr. Masyr jointly own all right, title and interest in and to that patent.

11. United States Patent No. 6,371,763B1 for FLEXIBLE POST IN A DENTAL POST AND CORE SYSTEM (the "763 patent"), a copy of which is annexed hereto

as Exhibit E, was duly and legally issued on April 16, 2002, and Dr. Sicurelli and Dr. Masyr jointly own all right, title and interest in and to that patent.

12. The patents in suit all relate to an endodontal device known as a dental post.

13. Devices known as dental posts are used by dentists and endodontists to restore teeth that have had root canal treatment. Traditionally, dental posts have been made of metals, which presents problems of discoloration of the crown or inlay, as well as problems associated with the propensity to fracture because metal dental posts are often less elastic and flexible than the natural dentin in the tooth itself. The patents in suit relate to innovative fiberglass-reinforced dental posts.

14. The dental posts disclosed and claimed in the patents in suit have flexibility that closely mimics that of the tissue of a natural tooth. They are also transparent or tooth colored, which is far superior cosmetically because there is no discoloration of the crown or inlay.

15. These inventions promote the restoration of endodontically treated teeth previously classified as hopeless due to extreme loss of tooth structure and provide several other significant advantages over the previously known technology, including, among other benefits, the reduction of:

- a) the time and equipment needed during a procedure (thus lessening the risk of perforating or fracturing the root canal during placement of the post),
- b) susceptibility for tooth fracture, and
- c) the mechanical weakening of tooth structure (by relieving stress concentrations).

16. Consequently, the inventions disclosed and claimed in the patents in suit have revolutionized the dental post market, received widespread acclaim among dentists and endodontists and achieved commercial success.

17. Without authority or license from Dr. Sicurelli and Dr. Masyr, Jeneric/Pentron began to manufacture, use, offer for sale and sell flexible fiberglass dental posts and associated products, including, but not limited to, the FibreKor[®] post system (the "FibreKor"), which embody the inventions disclosed and claimed in the patents in suit.

18. Dr. Sicurelli and Dr. Masyr informed Jeneric/Pentron of its infringing activities.

19. Jeneric/Pentron declined to cease its infringement of the patents in suit and failed to engage in good faith negotiations to compensate Dr. Sicurelli and Dr. Masyr for its infringement.

20. Instead, Jeneric/Pentron threatened Dr. Sicurelli and Dr. Masyr with a frivolous lawsuit if Dr. Sicurelli and Dr. Masyr began manufacturing, offering and selling products practicing any of their own patents.

21. Upon information and belief, Jeneric/Pentron had no good faith basis to believe that any such product would in fact infringe any patent owned by Jeneric/Pentron, but made this threat for the purpose of intimidating Dr. Sicurelli and Dr. Masyr and dissuading them from introducing onto the market a product that would be superior to any product related to patents owned by Jeneric/Pentron.

22. Upon information and belief, Jeneric/Pentron manufactures for others dental posts that infringe the patents in suit.

23. Jeneric/Pentron has infringed, and continues to infringe, the patents in suit in this judicial district and elsewhere throughout the United States, by making, using, offering to sell, and selling flexible fiberglass dental posts and associated products, including, but not limited to, the FibreKor, which embody inventions disclosed and claimed in those patents, by

actively inducing others to infringe those patents, and by contributing to the infringement of those patents, all without authority or license from Dr. Sicurelli and Dr. Masyr.

24. Jeneric/Pentron has willfully infringed the patents in suit.

25. This is an "exceptional case" within the meaning of 35 U.S.C. § 285.

26. As a result of said infringement by Jeneric/Pentron, Dr. Sicurelli and Dr. Masyr have been damaged in an amount to be determined at trial and have suffered and will continue to suffer irreparable injury unless Jeneric/Pentron is enjoined from further infringement.

PRAYER FOR RELIEF

WHEREFORE, Dr. Sicurelli and Dr. Masyr demand judgment against Jeneric/Pentron as follows:

a. That Jeneric/Pentron has been and is infringing, contributing to the infringement of, and actively inducing infringement of each of the '399, '139, '970, '044 and '763 patents by making, using, offering for sale, and/or selling the FibreKor;

b. That Jeneric/Pentron, its officers, employees, agents, servants and attorneys, and all others in active concert or participation with it or under its authority be permanently enjoined from making, using, offering for sale, and selling infringing flexible fiberglass posts and from otherwise infringing, contributing to infringement and actively inducing infringement of the '399, '139, '970, '044 and '763 patents;

c. For an accounting of damages to Dr. Sicurelli and Dr. Masyr arising from acts of infringement, contributory infringement and active inducement of infringement by Jeneric/Pentron, including profits made by Jeneric/Pentron and lost by Dr. Sicurelli and Dr. Masyr as a result of the activities of Jeneric/Pentron but in no event less than a reasonable royalty;

d. For an award to Dr. Sicurelli and Dr. Masyr of the actual damages so ascertained, together with interest and costs, in accordance with 35 U.S.C. § 284;

e. That Dr. Sicurelli and Dr. Masyr be awarded treble damages pursuant to 35 U.S.C. § 284; and

f. For such other and further relief as the Court deems just and proper.

DEMAND FOR JURY TRIAL

Dr. Sicurelli and Dr. Masyr demand trial by jury of all issues in this action so triable.

Dated: September 26, 2003
New York, New York

Respectfully submitted,

DEWEY BALLANTINE LLP

By: 

Bradford J. Badke (BB-1335)

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Attorneys for Plaintiffs Dr. Sicurelli and Dr. Masyr

UNITED STATES DISTRICT COURT
EASTERN DISTRICT OF NEW YORK**FILED**
IN CLERK'S OFFICE
U.S. DISTRICT COURT E.D.N.Y.
★ NOV 13 2003 ★
BROOKLYN OFFICE

DR. ROBERT SICURELLI and
DR. SAMUEL MASYS,

Plaintiffs,

-against

JENERIC/PENTRON INC.,

Defendant.

: Civil Action No. CV-03-4934
: (CBA)(SMG): **DEFENDANT'S ANSWER AND**
: **COUNTERCLAIMS**: **JURY TRIAL DEMANDED**

Defendant Jeneric/Pentron, Inc. (hereinafter "Pentron") answers the Complaint of the Plaintiffs Dr. Robert Sicurelli and Dr. Samuel Masys as follows:

1. Admitted.
2. Admitted.
3. Pentron admits Dr. Robert Sicurelli is listed as a named inventor on each of the patents in suit. Further answering, Pentron denies knowledge or information sufficient to form a belief as to the truth of the remaining allegations of paragraph 3 of the Complaint.
4. Pentron admits Dr. Samuel Masys is listed as a named inventor on each of the patents in suit. Further answering, Pentron denies knowledge or information sufficient to form a belief as to the remaining allegations of paragraph 4 of the Complaint.
5. Pentron denies knowledge or information sufficient to form a belief as to the allegations of paragraph 5 of the Complaint.

6. Pentron denies the allegations set forth in paragraph 6 of the Complaint, except admits that it is a Connecticut corporation having its principal place of business in Wallingford, Connecticut and previously carried out substantial trade and business within this judicial district and within the State of New York.
7. Pentron admits a copy of U.S. Patent No. 5,518,399 (the " '399 Patent") was attached to the Complaint as Exhibit A. Further answering, Pentron denies knowledge or information sufficient to form a belief as to the remaining allegations of paragraph 7 of the Complaint.
8. Pentron admits a copy of U.S. Patent No. 5,741,139 (the " '139 Patent") was attached to the Complaint as Exhibit B. Further answering, Pentron denies knowledge or information sufficient to form a belief as to the remaining allegations of paragraph 8 of the Complaint.
9. Pentron admits a copy of U.S. Patent No. 5,915,970 (the " '970 Patent") was attached to the Complaint as Exhibit C. Further answering, Pentron denies knowledge or information sufficient to form a belief as to the remaining allegations of paragraph 9 of the Complaint.
10. Pentron admits a copy of U.S. Patent No. 5,919,044 (the " '044 Patent") was attached to the Complaint as Exhibit D. Further answering, Pentron denies knowledge or information sufficient to form a belief as to the remaining allegations of paragraph 10 of the Complaint.
11. Pentron admits a copy of U.S. Patent No. 6,371,763 (the " '763 Patent") was attached to the Complaint as Exhibit E. Further answering, Pentron denies knowledge or information sufficient to form a belief as to the remaining

allegations of paragraph 11 of the Complaint.

12. Pentron denies the allegations set forth in paragraph 12 of the Complaint, except admits that certain of the patents appears to relate to dental posts and defendant Jentron respectfully refers this Court to the patents in suit as they are documents which speak for themselves.
13. Pentron denies the allegations set forth in paragraph 13 of the Complaint, except admits devices known as dental posts are used by dentists and endodontists to restore teeth that have had root canal treatment.
14. Denied.
15. Denied.
16. Denied.
17. Denied.
18. Pentron admits it was contacted by representatives of Dr. Sicurelli and Dr. Masyr concerning an allegation of infringement. Pentron denies the remaining allegations contained in paragraph 18 of the Complaint.
19. Denied.
20. Denied.
21. Denied.
22. Denied.
23. Denied.
24. Denied.
25. Denied.
26. Denied.

AS AND FOR A FIRST AFFIRMATIVE DEFENSE:

27. The Complaint fails to state a claim for which relief can be granted.

AS AND FOR A SECOND AFFIRMATIVE DEFENSE:

28. Pentron has not been infringing and is not infringing, actively inducing others to infringe, or contributing to the infringement, of any of the claims of any of the patents in suit.

AS AND FOR A THIRD AFFIRMATIVE DEFENSE:

29. By reason of the proceedings in the United States Patent and Trademark Office during the prosecution of the applications that resulted in the patents in suit, including statements, arguments, amendments to the claims made during said prosecution by or on behalf of the patentees, Plaintiffs are estopped to assert that Pentron infringed or is infringing the patents in suit.

AS AND FOR A FOURTH AFFIRMATIVE DEFENSE:

30. The patents in suit are invalid under 35 U.S.C. §§ 102, 103, and 112.

AS AND FOR A FIFTH AFFIRMATIVE DEFENSE:

31. The Plaintiffs are guilty of laches and/or are otherwise estopped from asserting the patents in suit.

COUNTERCLAIMS**COUNT I**

(Declaratory Judgment of Invalidity and Non-infringement of U.S. Patent No. 5,518,399)

32. Counterclaim-Plaintiff Jeneric/Pentron Inc. (hereinafter "Defendant/Counterclaim-Plaintiff") is a corporation organized and existing under the laws of the State of Connecticut with its principal place of business in Wallingford, Connecticut.
33. Counterclaim-Defendant Dr. Robert Sicurelli ("Sicurelli") is a dentist and prosthodontist practicing in Brooklyn, New York. Counterclaim-Defendant Dr. Samuel Masyr ("Masyr") is a dentist and endodontist practicing in Brooklyn, New York. (Collectively, "Sicurelli" and "Masyr" are known as "Plaintiffs/Counterclaim-Defendants").
34. Defendant/Counterclaim-Plaintiff repeats and realleges the allegations contained in paragraphs 1 through 31 of this Answer and incorporates them into Count I by reference.
35. This is an action for Declaratory Judgment pursuant to 28 U.S.C. § 2201, for the purpose of determining a question of actual controversy between Plaintiffs/Counterclaim-Defendants and Defendant/Counterclaim-Plaintiff.
36. This Court has jurisdiction over this action pursuant to the provisions of 28 U.S.C. §§1331 and 1338 in that the action arises under the Patent Laws of the United States, Title 35, United States Code.
37. In light of the actual controversy existing between Defendant/Counterclaim-

Plaintiff and Plaintiffs/Counterclaim-Defendants by virtue of the Complaint filed by Plaintiffs/Counterclaim-Defendants, Defendant/Counterclaim-Plaintiff is entitled to a judgment declaring that Defendant/Counterclaim-Plaintiff does not infringe the '399 Patent and that the '399 Patent is invalid.

COUNT II

(Declaratory Judgment of Invalidity and Non-infringement of U.S. Patent No. 5,741,139)

38. Defendant/Counterclaim-Plaintiff repeats and realleges the allegations contained in paragraphs 1 through 35 of this Answer and incorporates them into Count II by reference.
39. This is an action for Declaratory Judgment pursuant to 28 U.S.C. § 2201, for the purpose of determining a question of actual controversy between Plaintiffs/Counterclaim-Defendants and Defendant/Counterclaim-Plaintiff.
40. This Court has jurisdiction over this action pursuant to the provisions of 28 U.S.C. §§1331 and 1338 in that the action arises under the Patent Laws of the United States, Title 35, United States Code.
41. In light of the actual controversy existing between Defendant/Counterclaim-Plaintiff and Plaintiffs/Counterclaim-Defendants by virtue of the Complaint filed by Plaintiffs/Counterclaim-Defendants, Defendant/Counterclaim-Plaintiff is entitled to a judgment declaring that Defendant/Counterclaim-Plaintiff does not infringe the '399 Patent and that the '399 Patent is invalid.

COUNT III

(Declaratory Judgment of Invalidity and Non-infringement of U.S. Patent No. 5,915,970)

42. Defendant/Counterclaim-Plaintiff repeats and realleges the allegations contained in paragraphs 1 through 39 of this Answer and incorporates them into Count III by reference.
43. This is an action for Declaratory Judgment pursuant to 28 U.S.C. § 2201, for the purpose of determining a question of actual controversy between Plaintiffs/Counterclaim-Defendants and Defendant/Counterclaim-Plaintiff.
44. This Court has jurisdiction over this action pursuant to the provisions of 28 U.S.C. §§1331 and 1338 in that the action arises under the Patent Laws of the United States, Title 35, United States Code.
45. In light of the actual controversy existing between Defendant/Counterclaim-Plaintiff and Plaintiffs/Counterclaim-Defendants by virtue of the Complaint filed by Plaintiffs/Counterclaim-Defendants, Defendant/Counterclaim-Plaintiff is entitled to a judgment declaring that Defendant/Counterclaim-Plaintiff does not infringe the '399 Patent and that the '399 Patent is invalid.

COUNT IV

(Declaratory Judgment of Invalidity and Non-infringement of U.S. Patent No. 5,919,044)

46. Defendant/Counterclaim-Plaintiff repeats and realleges the allegations contained in paragraphs 1 through 43 of this Answer and incorporates them into Count IV by reference.
47. This is an action for Declaratory Judgment pursuant to 28 U.S.C. § 2201, for the purpose of determining a question of actual controversy between

Plaintiffs/Counterclaim-Defendants and Defendant/Counterclaim-Plaintiff.

48. This Court has jurisdiction over this action pursuant to the provisions of 28 U.S.C. §§1331 and 1338 in that the action arises under the Patent Laws of the United States, Title 35, United States Code.
49. In light of the actual controversy existing between Defendant/Counterclaim-Plaintiff and Plaintiffs/Counterclaim-Defendants by virtue of the Complaint filed by Plaintiffs/Counterclaim-Defendants, Defendant/Counterclaim-Plaintiff is entitled to a judgment declaring that Defendant/Counterclaim-Plaintiff does not infringe the '399 Patent and that the '399 Patent is invalid.

COUNT V

(Declaratory Judgment of Invalidity and Non-infringement U.S. Patent No. 6,371,763)

50. Defendant/Counterclaim-Plaintiff repeats and realleges the allegations contained in paragraphs 1 through 47 of this Answer and incorporates them into Count V by reference.
51. This is an action for Declaratory Judgment pursuant to 28 U.S.C. § 2201, for the purpose of determining a question of actual controversy between Plaintiffs/Counterclaim-Defendants and Defendant/Counterclaim-Plaintiff.
52. This Court has jurisdiction over this action pursuant to the provisions of 28 U.S.C. §§1331 and 1338 in that the action arises under the Patent Laws of the United States, Title 35, United States Code.
53. In light of the actual controversy existing between Defendant/Counterclaim-Plaintiff and Plaintiffs/Counterclaim-Defendants by virtue of the Complaint filed by Plaintiffs/Counterclaim-Defendants, Defendant/Counterclaim-Plaintiff is entitled to a judgment declaring that Defendant/Counterclaim-Plaintiff does not

infringe the '399 Patent and that the '399 Patent is invalid.

WHEREFORE, the Defendant/Counterclaim-Plaintiff demands judgment:

- A. That the Complaint be dismissed with prejudice;
- B. That the Defendant/Counterclaim-Plaintiff be awarded judgment in its favor on its Counterclaims;
- C. That on Count I of the Defendant/Counterclaim Plaintiff's Counterclaim for declaratory judgment concerning the '339 Patent, the Court declares that the '339 Patent is invalid and that Defendant/Counterclaim-Plaintiff does not infringe any claim of the '339 Patent;
- D. That on Count II of the Defendant/Counterclaim-Plaintiff's Counterclaim for declaratory judgment concerning the '139 Patent, the Court declares that the '139 Patent is invalid and that Defendant/Counterclaim-Plaintiff does not infringe any claim of the '139 Patent;
- E. That on Count III of the Defendant/Counterclaim-Plaintiff's Counterclaim for declaratory judgment concerning the '970 Patent, the Court declares that the '970 Patent is invalid and that Defendant/Counterclaim-Plaintiff does not infringe any claim of the '970 Patent;
- F. That on Count IV of the Defendant/Counterclaim-Plaintiff's Counterclaim for declaratory judgment concerning the '044 Patent, the Court declares that the '044 Patent is invalid and that Defendant/Counterclaim-Plaintiff does not infringe any claim of the '044 Patent;
- G. That on Count V of the Defendant/Counterclaim-Plaintiff's Counterclaim for declaratory judgment concerning the '763 Patent, the Court declares that the

'763 Patent is invalid and that Defendant/Counterclaim-Plaintiff does not infringe any claim of the '763 Patent;

- H. That the Court declare this matter to be an exceptional case within the meaning of 35 U.S.C. §285;
- I. That the Court award Defendant/Counterclaim-Plaintiff its costs and expenses included therein, including reasonable attorneys' fees; and
- J. That the Court award Defendant/Counterclaim-Plaintiff such other and further relief as the Court deem just and proper.

Dated: New York, New York
November 12, 2003

DRINKER BIDDLE & REATH LLP

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Lisa B. Deutsch (LD-8190)
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Attorneys for Plaintiffs/
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Dr. Robert Sicurelli
and Dr. Samuel Masyr

UNITED STATES DISTRICT COURT
EASTERN DISTRICT OF NEW YORKFILED
IN CLERK'S OFFICE
U.S. DISTRICT COURT E.D.N.Y.

★ NOV 13 2003 ★

BROOKLYN OFFICE

DR. ROBERT SICURELLI and
DR. SAMUEL MASYS,

Plaintiffs,

-against

JENERIC/PENTRON INC.,

Defendant.

: Civil Action No. CV-03-4934
: (CBA)(SMG): DEFENDANT'S ANSWER AND
: COUNTERCLAIMS

: JURY TRIAL DEMANDED

Defendant Jeneric/Pentron, Inc. (hereinafter "Pentron") answers the Complaint of the Plaintiffs Dr. Robert Sicurelli and Dr. Samuel Masys as follows:

1. Admitted.
2. Admitted.
3. Pentron admits Dr. Robert Sicurelli is listed as a named inventor on each of the patents in suit. Further answering, Pentron denies knowledge or information sufficient to form a belief as to the truth of the remaining allegations of paragraph 3 of the Complaint.
4. Pentron admits Dr. Samuel Masys is listed as a named inventor on each of the patents in suit. Further answering, Pentron denies knowledge or information sufficient to form a belief as to the remaining allegations of paragraph 4 of the Complaint.
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6. Pentron denies the allegations set forth in paragraph 6 of the Complaint, except admits that it is a Connecticut corporation having its principal place of business in Wallingford, Connecticut and previously carried out substantial trade and business within this judicial district and within the State of New York.
7. Pentron admits a copy of U.S. Patent No. 5,518,399 (the " '399 Patent") was attached to the Complaint as Exhibit A. Further answering, Pentron denies knowledge or information sufficient to form a belief as to the remaining allegations of paragraph 7 of the Complaint.
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11. Pentron admits a copy of U.S. Patent No. 6,371,763 (the " '763 Patent") was attached to the Complaint as Exhibit E. Further answering, Pentron denies knowledge or information sufficient to form a belief as to the remaining

allegations of paragraph 11 of the Complaint.

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16. Denied.
17. Denied.
18. Pentron admits it was contacted by representatives of Dr. Sicurelli and Dr. Masyr concerning an allegation of infringement. Pentron denies the remaining allegations contained in paragraph 18 of the Complaint.
19. Denied.
20. Denied.
21. Denied.
22. Denied.
23. Denied.
24. Denied.
25. Denied.
26. Denied.

AS AND FOR A FIRST AFFIRMATIVE DEFENSE:

27. The Complaint fails to state a claim for which relief can be granted.

AS AND FOR A SECOND AFFIRMATIVE DEFENSE:

28. Pentron has not been infringing and is not infringing, actively inducing others to infringe, or contributing to the infringement, of any of the claims of any of the patents in suit.

AS AND FOR A THIRD AFFIRMATIVE DEFENSE:

29. By reason of the proceedings in the United States Patent and Trademark Office during the prosecution of the applications that resulted in the patents in suit, including statements, arguments, amendments to the claims made during said prosecution by or on behalf of the patentees, Plaintiffs are estopped to assert that Pentron infringed or is infringing the patents in suit.

AS AND FOR A FOURTH AFFIRMATIVE DEFENSE:

30. The patents in suit are invalid under 35 U.S.C. §§ 102, 103, and 112.

AS AND FOR A FIFTH AFFIRMATIVE DEFENSE:

31. The Plaintiffs are guilty of laches and/or are otherwise estopped from asserting the patents in suit.

COUNTERCLAIMS**COUNT I**

(Declaratory Judgment of Invalidity and Non-infringement of U.S. Patent No. 5,518,399)

32. Counterclaim-Plaintiff Jeneric/Pentron Inc. (hereinafter "Defendant/Counterclaim-Plaintiff") is a corporation organized and existing under the laws of the State of Connecticut with its principal place of business in Wallingford, Connecticut.
33. Counterclaim-Defendant Dr. Robert Sicurelli ("Sicurelli") is a dentist and prosthodontist practicing in Brooklyn, New York. Counterclaim-Defendant Dr. Samuel Masyr ("Masyr") is a dentist and endodontist practicing in Brooklyn, New York. (Collectively, "Sicurelli" and "Masyr" are known as "Plaintiffs/Counterclaim-Defendants").
34. Defendant/Counterclaim-Plaintiff repeats and realleges the allegations contained in paragraphs 1 through 31 of this Answer and incorporates them into Count I by reference.
35. This is an action for Declaratory Judgment pursuant to 28 U.S.C. § 2201, for the purpose of determining a question of actual controversy between Plaintiffs/Counterclaim-Defendants and Defendant/Counterclaim-Plaintiff.
36. This Court has jurisdiction over this action pursuant to the provisions of 28 U.S.C. §§1331 and 1338 in that the action arises under the Patent Laws of the United States, Title 35, United States Code.
37. In light of the actual controversy existing between Defendant/Counterclaim-

Plaintiff and Plaintiffs/Counterclaim-Defendants by virtue of the Complaint filed by Plaintiffs/Counterclaim-Defendants, Defendant/Counterclaim-Plaintiff is entitled to a judgment declaring that Defendant/Counterclaim-Plaintiff does not infringe the '399 Patent and that the '399 Patent is invalid.

COUNT II

(Declaratory Judgment of Invalidity and Non-infringement of U.S. Patent No. 5,741,139)

38. Defendant/Counterclaim-Plaintiff repeats and realleges the allegations contained in paragraphs 1 through 35 of this Answer and incorporates them into Count II by reference.
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40. This Court has jurisdiction over this action pursuant to the provisions of 28 U.S.C. §§1331 and 1338 in that the action arises under the Patent Laws of the United States, Title 35, United States Code.
41. In light of the actual controversy existing between Defendant/Counterclaim-Plaintiff and Plaintiffs/Counterclaim-Defendants by virtue of the Complaint filed by Plaintiffs/Counterclaim-Defendants, Defendant/Counterclaim-Plaintiff is entitled to a judgment declaring that Defendant/Counterclaim-Plaintiff does not infringe the '399 Patent and that the '399 Patent is invalid.

COUNT III

(Declaratory Judgment of Invalidity and Non-infringement of U.S. Patent No. 5,915,970)

42. Defendant/Counterclaim-Plaintiff repeats and realleges the allegations contained in paragraphs 1 through 39 of this Answer and incorporates them into Count III by reference.
43. This is an action for Declaratory Judgment pursuant to 28 U.S.C. § 2201, for the purpose of determining a question of actual controversy between Plaintiffs/Counterclaim-Defendants and Defendant/Counterclaim-Plaintiff.
44. This Court has jurisdiction over this action pursuant to the provisions of 28 U.S.C. §§1331 and 1338 in that the action arises under the Patent Laws of the United States, Title 35, United States Code.
45. In light of the actual controversy existing between Defendant/Counterclaim-Plaintiff and Plaintiffs/Counterclaim-Defendants by virtue of the Complaint filed by Plaintiffs/Counterclaim-Defendants, Defendant/Counterclaim-Plaintiff is entitled to a judgment declaring that Defendant/Counterclaim-Plaintiff does not infringe the '399 Patent and that the '399 Patent is invalid.

COUNT IV

(Declaratory Judgment of Invalidity and Non-infringement of U.S. Patent No. 5,919,044)

46. Defendant/Counterclaim-Plaintiff repeats and realleges the allegations contained in paragraphs 1 through 43 of this Answer and incorporates them into Count IV by reference.
47. This is an action for Declaratory Judgment pursuant to 28 U.S.C. § 2201, for the purpose of determining a question of actual controversy between

Plaintiffs/Counterclaim-Defendants and Defendant/Counterclaim-Plaintiff.

48. This Court has jurisdiction over this action pursuant to the provisions of 28 U.S.C. §§1331 and 1338 in that the action arises under the Patent Laws of the United States, Title 35, United States Code.
49. In light of the actual controversy existing between Defendant/Counterclaim-Plaintiff and Plaintiffs/Counterclaim-Defendants by virtue of the Complaint filed by Plaintiffs/Counterclaim-Defendants, Defendant/Counterclaim-Plaintiff is entitled to a judgment declaring that Defendant/Counterclaim-Plaintiff does not infringe the '399 Patent and that the '399 Patent is invalid.

COUNT V

(Declaratory Judgment of Invalidity and Non-infringement U.S. Patent No. 6,371,763)

50. Defendant/Counterclaim-Plaintiff repeats and realleges the allegations contained in paragraphs 1 through 47 of this Answer and incorporates them into Count V by reference.
51. This is an action for Declaratory Judgment pursuant to 28 U.S.C. § 2201, for the purpose of determining a question of actual controversy between Plaintiffs/Counterclaim-Defendants and Defendant/Counterclaim-Plaintiff.
52. This Court has jurisdiction over this action pursuant to the provisions of 28 U.S.C. §§1331 and 1338 in that the action arises under the Patent Laws of the United States, Title 35, United States Code.
53. In light of the actual controversy existing between Defendant/Counterclaim-Plaintiff and Plaintiffs/Counterclaim-Defendants by virtue of the Complaint filed by Plaintiffs/Counterclaim-Defendants, Defendant/Counterclaim-Plaintiff is entitled to a judgment declaring that Defendant/Counterclaim-Plaintiff does not

infringe the '399 Patent and that the '399 Patent is invalid.

WHEREFORE, the Defendant/Counterclaim-Plaintiff demands judgment:


- A. That the Complaint be dismissed with prejudice;
- B. That the Defendant/Counterclaim-Plaintiff be awarded judgment in its favor on its Counterclaims;
- C. That on Count I of the Defendant/Counterclaim Plaintiff's Counterclaim for declaratory judgment concerning the '339 Patent, the Court declares that the '339 Patent is invalid and that Defendant/Counterclaim-Plaintiff does not infringe any claim of the '339 Patent;
- D. That on Count II of the Defendant/Counterclaim-Plaintiff's Counterclaim for declaratory judgment concerning the '139 Patent, the Court declares that the '139 Patent is invalid and that Defendant/Counterclaim-Plaintiff does not infringe any claim of the '139 Patent;
- E. That on Count III of the Defendant/Counterclaim-Plaintiff's Counterclaim for declaratory judgment concerning the '970 Patent, the Court declares that the '970 Patent is invalid and that Defendant/Counterclaim-Plaintiff does not infringe any claim of the '970 Patent;
- F. That on Count IV of the Defendant/Counterclaim-Plaintiff's Counterclaim for declaratory judgment concerning the '044 Patent, the Court declares that the '044 Patent is invalid and that Defendant/Counterclaim-Plaintiff does not infringe any claim of the '044 Patent;
- G. That on Count V of the Defendant/Counterclaim-Plaintiff's Counterclaim for declaratory judgment concerning the '763 Patent, the Court declares that the

'763 Patent is invalid and that Defendant/Counterclaim-Plaintiff does not infringe any claim of the '763 Patent;

- H. That the Court declare this matter to be an exceptional case within the meaning of 35 U.S.C. §285;
- I. That the Court award Defendant/Counterclaim-Plaintiff its costs and expenses included therein, including reasonable attorneys' fees; and
- J. That the Court award Defendant/Counterclaim-Plaintiff such other and further relief as the Court deem just and proper.

Dated: New York, New York
November 12, 2003

DRINKER BIDDLE & REATH LLP

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